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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,245	08/31/2000	David A. Cordray	AUS9-2000-0403-US1	4517

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EXAMINER

FLYNN, KIMBERLY D

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 07/08/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/653,245

Applicant(s)

CORDRAY ET AL.

Examiner

Kimberly D Flynn

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to Applicant's Response to Office Action filed April 15, 2004. Claims 1-23 are presented for further consideration.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 4, 10-13, 15, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDowell et al. (U.S. Patent No. 6,438,583 hereinafter, McDowell) in view of Henderson (U.S. Patent No. 6,185,603, hereinafter Henderson).

In considering claims 1, 4, 11-12, 15, and 22, McDowell discloses a system and method for re-routing electronic mail messages, the method comprising:

determining whether the electronic mail message for a recipient is to be forwarded to another address associated with the recipient (*Col 8, lines 32-37, McDowell discloses the re-route server, after receiving e-mail; determines if the recipient of the e-mail is a re-route customer, wherein if the recipient is determined to be a re-route customer then it is determined that the e-mail for the recipient is to be forwarded to the recipient's "toAccount" address or another address provided by the recipient*);

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while McDowell discloses a system for re-routing or forwarding e-mail from a prior or non-working address to a new address of a recipient, McDowell does not particularly disclose including an indicator identifying the message as forwarded from an old address if the electronic message is to be forwarded to another address associated with the recipient. Nonetheless, including an indicator that identifies a message as forwarded and from where it was forwarded is well known in the art as evidenced by Henderson.

In similar art Henderson discloses a system for the delivery of e-mail and alerting messages wherein typical email messages include normal headers and a message portion that indicates the source of the message and from where it was forwarded (col. 5, lines 52-55).

Given the teachings of Henderson a person having ordinary skill in the art would have readily recognized the uses and advantages of modifying the system for re-routing e-mail messages, as disclosed by McDowell, by including the well known indicator that identifies the message as being forwarded from an old address, such as disclosed by Henderson, in order to distinguish the forwarded e-mail from the regularly received e-mail and also to inform the user that the e-mail was sent from a known and secure source.

In considering claims 2 and 13, McDowell discloses sending the message after including the indicator (*col. 8, lines 40-43*).

In considering claims 8 and 19, McDowell discloses means for updating a billing database for including the indicator for the recipient (*col. 14, lines 45-46*).

In considering claims 10, 21, and 23 McDowell discloses a system and method for forwarding an electronic mail message comprising:

receiving a signal to forward the electronic mail message to another address (*col. 11, lines 12-21*);

while McDowell discloses a system for re-routing or forwarding e-mail from a prior or non-working address to a new address of a recipient, McDowell does not particularly disclose including an indicator identifying the message or mail as forwarded from an old address if the message or mail is to be forwarded to another address associated with the recipient.

Nonetheless, including an indicator that identifies a message as forwarded and from where it was forwarded is well known in the art.

Using similar semi-automated procedures, the USPS (United States Postal Service) uses a National Change of Address system that involves identifying, intercepting, and forwarding incorrectly addressed mail. When a mail piece is identified as in need of forwarding, it is manually segregated, by the carrier, from the mail stream to a USPS Computerized Forwarding System (CFS) for address correction. The CFS currently utilized by the USPS is a semi-automated computerized machine that transports incorrectly addressed mail pieces past human operators where it is later tagged for forwarding and manually or mechanically labeled (indicator) with a forwarding address prior to being returned for normal processing and delivery (see *col. 1, lines 22-56*).

Allen, whose system is an apparatus for intercepting and forwarding postal mail discloses wherein when mail is identified as in need of forwarding, the forwarding address and delivery point ZIP marking number are printed on the mail piece in place of the incorrect address and the mail piece is returned to the mail stream for delivery to the addressee (see abstract).

Although the environments are different one being semi-automated and one manual, the schemes for which the processes are completed are functionally equivalent. It would only require routine skill in the art to automate a known process. See *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194(CCPA 1958).

Given the teachings of Allen a person having ordinary skill in the art would have readily recognized the uses and advantages of automating the manual postal mail forwarding system of including an indicator or marking in place of the incorrect address indicating the mail as being forwarded and indicating that the old address is no longer current for the recipient order to distinguish the forwarded mail or messages from the regularly received mail or messages.

4. Claims 3, 5-9, 14, 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDowell in view of Allen in further view of Berkowitz (U.S. Patent No. 6,088,720 hereinafter, Berkowitz)

In considering claims 3,5-7, 9, 14,16-18, and 20, while McDowell discloses the system substantially as claimed McDowell does not expressly disclose wherein the indicator can be represented by one of the following: text in the body of the electronic message, an audio indicator, a presentation of a wave file, a graphical indicator, or an advertisement. However, it is well known for e-mail systems to have the capability to incorporate various attachments to e-mail such as text, sound clips, WAV files, video clips, and graphics as evidenced by Berkowitz (col. 2, lines 20-24). While most e-mail clients can accommodate the receipt of any type of file, some e-mail clients are limited to specific types.

It would have been obvious to a person having ordinary skill in the art to recognize the desirability and advantages of modifying the system as disclosed by McDowell to include indicators of different forms in order accommodate the specifications of the receivers' e-mail client. Therefore, the claimed limitation would have been an obvious modification to the system disclosed by McDowell.

Response to Arguments

5. Applicant's arguments with respect to claims 1-23 have been considered, but are moot in view of the new ground(s) of rejection.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly D Flynn whose telephone number is 703-308-7609. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703-305-3900).

Kimberly D Flynn
Examiner
Art Unit 2153

KF
June 28, 2004


GLEN B. BURGESS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100